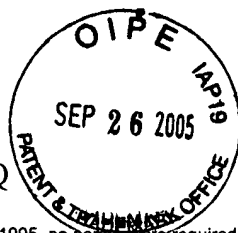


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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

81230.68453

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on SEPTEMBER 21, 2005Signature Ranni MatarTyped or printed name RANNI MATAR

Application Number

10/758,820

Filed

01/16/2004

First Named Inventor

JOSEPH LEE HAUGHAWOUT

Art Unit

2635

Examiner

Yang, CLARA I.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☒ attorney or agent of record.
Registration number 35,906
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

GARY R. JAROSIK

Typed or printed name

(312) 456-8449

Telephone number

SEPTEMBER 21, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REASONS FOR REVIEW REQUEST

In the application claims 1-14, 29-40, 43, and 44 remain pending. Claims 15-28, 41, and 42 have been canceled without prejudice. No claims presently stand allowed. The reconsideration of the rejection of the claims is, however, respectfully requested.

The pending claims presently stand rejected under 35 U.S.C. § 103 as being rendered obvious primarily in view of the combination of Kamon (U.S. Patent No. 5,726,645) and Ivie (U.S. Patent No. 5,815,086). In rejecting the claims, it was set forth that Kamon discloses a remote control system having a detecting circuit associated with an appliance wherein the detecting circuit has circuitry for determining a state of an appliance and for transmitting to a remote control a signal for use in configuring the remote control. While it was acknowledged that Kamon fails to disclose a device for monitoring power supplied to an appliance, Kamon instead disclosing detection circuitry which monitors an appliance headphone jack, it was set forth that Ivie discloses a remote control system comprising a universal transmitter associated with an appliance which includes a power monitor for monitoring power supplied to the appliance to determine the state of the appliance and a wireless transmitter (which it is to be noted is used to transmit commands to nothing more than the appliance) as well as a hand-held remote controller having a library of command codes. Thus, the Office Action concluded that it would have been obvious to modify Kamon's detecting circuitry as taught by Ivie for the reason that it would enable the "headphone plug 10a of Kamon's appliance 20 to be free for its intended use instead of being used as a power monitor."

In response it is respectfully submitted that the rejection under 35 U.S.C. § 103 reflects the impermissible use of the specification of the applicant as a template to combine the parts of the references cited for the purpose of deprecating the invention claimed. More particularly, it is respectfully submitted that the rejection of the claims reflects the impermissible use of "hindsight

reasoning” since it has not been demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references cited and combined them in the claimed manner. Rather, the rejection appears to be impermissibly relying upon the mere fact that references can be combined or modified which it is well established does not render the resultant combination *prima facie* obvious unless the prior art also suggests the desirability of the combination.

With these requirements for maintaining a rejection under 35 U.S.C. § 103 in mind, it is first respectfully submitted that nothing from Ivie discloses, teaches, or suggests that it would be desirable to modify the system of Kamon to enable the headphone plug of Kamon’s appliance to be free for its intended use instead of being used as a power monitor which is the rationale for the modification espoused in the rejection of the claims. Accordingly, it is submitted that the determination of obviousness set forth in the rejection of the claims, which relies upon a motivation that finds no basis in any cited reference, reflects the impermissible use of hindsight reasoning. For at least this reason it is respectfully submitted that the rejection of the claims should be withdrawn.

Second, it is respectfully submitted that, even if one of ordinary skill in the art were motivated to modify Kamon for the purpose of enabling the headphone plug of Kamon’s appliance to be free for its intended use instead of being used as a power monitor, the express teachings of Ivie would suggest meeting this objective in a manner that is not in keeping with the manner asserted in the rejection of the claims. In this regard, when Ivie is considered in its entirety (as is required), the express teachings of Ivie suggest that the headphone jack of Kamon’s appliance may be rendered free not by modifying the power monitor of Kamon but instead by removing the Kamon power monitor from the headphone jack and modifying the remote control of Kamon whereupon the remote control of Kamon remains configurable by a

user entering a number on the keypad to select which set of infrared codes from a library of infrared codes will apply. (Col. 8, lines 34-52). Thus, it will be appreciated that modifying Kamon in the only manner that is in keeping with both the express teachings of Ivie and the espoused modification objective would not lead one of ordinary skill in the art to the invention claimed. For this additional reason it is respectfully submitted that a *prima facie* case of obviousness has not been presented and the rejection of the claims should be withdrawn.

Third, it is respectfully submitted that when the obviousness analysis considers only the teachings within Kamon and Ivie without regard to the unsupported modification objective that has been espoused in the rejection of the claims, neither Kamon nor Ivie can be said to disclose, teach, or suggest the desirability of providing a device which monitors power supplied to an appliance with the capability of transmitting a signal to a controlling device which indicates to the controlling device that a transmitted command code caused a change in a current power state of the appliance to thereby cause a configuration of the controlling device as is claimed. That Kamon fails to disclose, teach, or suggest this claimed element has been acknowledged in the rejection of the claims. It is submitted that Ivie also fails to disclose, teach, or suggest this claimed element. While Ivie does disclose a power monitor having an IR transmitter, the power monitor of Ivie does not function to monitor power supplied to an appliance to cause the IR transmitter to transmit a signal to a controlling device which indicates to the controlling device that a transmitted command code caused a change in a current power state of the appliance to thereby cause a configuration of the controlling device. Rather, Ivie only discloses, teaches, and suggests monitoring power supplied to an appliance to determine if the IR transmitter should proceed with the transmitting of a power toggle command to an appliance, i.e., Ivie does not disclose, teach, or suggest that any signal is generated for any purpose in response to a detected change in power state. (Col. 7, lines 8-20). Thus, absent the disclosure of at least this claimed

element, the limited teachings of Ivie cannot be said to suggest the desirability of modifying the Kamon system whereby the disadvantages that are associated with the Kamon system are overcome, e.g., the fact that the Kamon system cannot be utilized to select a command code set for an appliance that does not generate an audio output, will not function in the case where the appliance is inadvertently muted, and will not function in the case where the appliance in question is not receiving an audio/video input which is required for the appliance to generate an audio output. In this light, it is respectfully submitted that, when Ivie is fully and fairly considered in its entirety, nothing from Ivie can be said to suggest any reason for modifying Kamon to arrive at the invention set forth in the claims. For this reason it is respectfully submitted that the express teachings of Ivie cannot support a *prima facie* case of obviousness and the rejection of the claims should be withdrawn.